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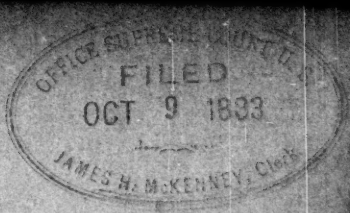

U. S. SUPREME COURT.

No. 95.

WENDELL R. KING,

Appellant,

vs.

AUGUST GALLUN & ALBERT TROSTEL,

Appellees.

BRIEF OF APPELLEES.

JOSHUA STARK,

Sol. for Appellees.

BYRES, SWAIN & CO. PRINTERS, 414 BROADWAY, MIL.

Supreme Court of the United States.

No. 95.

WENDELL R. KING, APPELLANT.

vs.

AUGUST GALLUN AND ALBERT TROSTEL, APPELLEES.

BRIEF OF APPELLEES.

Appeal from decree of the Circuit Court for the Eastern District of Wisconsin, dismissing the bill of the appellant upon the merits, after final hearing upon pleadings and proofs. (Case reported in 8 Bissell's Rep., 510.)

The bill was filed April 13, 1876, to obtain a perpetual injunction restraining the defendants from infringing the appellant's patent for a certain bale of plasterer's hair, as an article of manufacture, and to compel the appellees to account for profits, &c.

The patent referred to, is No. 152,560, dated June 30, 1874, and issued to Wendell R. King the appellant. (Patent and Specifications, Record, pp. 24, 25 and 26.)

The answer (pp. 6, 7 and 8,) admitted the issue of the patent and that the defendants (appellees) had put up plasterer's hair and sold it in bundles or bales, substantially such as are described in and attempted to be covered by the patent, but alleged that the "pretended invention and improvement, intended to be covered and secured by

said letters patent, and described in the schedule and drawings thereto annexed, is neither a new and useful art, nor a machine, manufacture, or composition of matter, nor a new and useful improvement thereof, within the meaning of the patent laws of the United States, and *the same was not and is not the subject of letters patent* under the laws of the United States, and *said letters patent are therefore void and* ineffectual to secure to the said complainant any exclusive right or privilege, as claimed in and by his said bill."

The answer further alleged that the mode of baling described in said patent was not new, but had been in common use among manufacturers and merchants in the United States and Europe for more than ten years before the date of the patent, in the packing and baling of yarns, worsteds, battings, tobaccos and many other articles of merchandise, for greater convenience of transportation and subsequent separation into parcels of uniform quantity and weight.

The defense was want of patentability and novelty.

The proofs tended to show that plasterer's hair had before been put up for transportation and sale in barrels and sacks, and also compressed in bales containing several bushels (by weight); and that when put up in bales composed of several packages of one bushel each, compressed together in one bale, it proved more convenient to the trade as an article of merchandise, and sometimes commanded a higher price. It further appeared from the proofs that plasterer's hair, baled as described in the appellant's patent, was not thereby affected in quality, or changed in any manner except as to bulk and division. The sole advantage or effect of such baling was to render it more convenient for handling and for transportation.

The patent describes the invention as a "*new and useful improvement in baling plastering hair.*" (Record, fol. 57.)

The specifications referred to in the patent state that "the wants of the trade in plastering hair require it to be compressed for transportation in packages of from three to five bushels," such packages being of a good size to conveniently handle; that

> "Heretofore this hair has been packed in a mass of a certain number of bushels baled together, varying in amount as the order required, so that when received the retail dealer was com-

pelled to parcel out the same and weigh it to suit his customers. This is a disagreeable and difficult thing to do, as the hair is dirty and matted together, and after it is once removed from the case, into which it has been compressed by a baling press, is bulky and not easy to reduce again to a convenient package."

For the convenience of the trade the inventor proposed to compress together several distinct bundles in paper sacks, each containing one bushel of hair, thus forming a single package or bale of convenient size and weight for transportation, composed of several distinct packages of uniform weight, each of which may be separated from the bale and remain compressed into a small size and in convenient condition to handle.

The patentee claimed as his invention,

> "*as an article of manufacture, the bale of plasterer's hair*, consisting of several bundles containing a bushel each by weight, inclosed or incased in paper bags or similar material, and united, compressed and secured to form a package, substantially as specified." (Page 25, fol. 59.)

Is such a bale patentable as an article of manufacture?

The patent is not for an improvement of the hair. The quality of the hair is not affected. It is made neither better nor worse in any respect by such baling, for any use to which it can be put.

Neither is the patent for the compression of hair into bales, nor for the paper bags or other material in which the hair is placed before compression. It is stated in the specifications that it had been usual to compress hair into bales for the trade. It is well known that many bulky articles have from time immemorial been so baled for transportation and trade. Cotton, hops and hay are examples. The bags and other envelopes were equally common and well known.

The patent does not cover a *single* package of hair, whether of one bushel or of more than one, compressed into a bale. The defendants might put up hair in paper bags, or in sacks or envelopes of any kind, and compress the same in single parcels or bundles, making bales of any size, without infringing this patent.

It is only when several separate bundles of one bushel each are compressed together at one time into one bale, that the patented article is produced.

One may use bags, sacks, compression, etc., to prepare the hair for transportation and for the trade in bales of one bushel, or of several bushels, without infringing the patent. Only when he places several packages of one bushel each side by side, and compresses them together at once, so that they can be tied up and handled as one bale, that he trespasses upon the appellant's invention.

This is the length and breadth of the invention: the bringing together of several bundles of an article of merchandise, of like quantity or weight, and compressing them together to form a bale.

Can the formation of such a bale be called invention? Is there anything in the structure of the bale, new, original, or requiring the exercise of intellect or ingenuity?

It may be that plasterer's hair was first put up in such bales by the appellant, but what degree of wit, intelligence or skill was required to discover that hair could be so baled, as well as the thousand other articles which had, time out of mind, been given to the trade in bales of the same kind?

Witnesses testified that from their earliest recollection, covering many years, wool, hides, hay, shoe-thread, carpet-warp, sheetings and other dry goods, grain bags, yarns, cotton bats, zephyr wool, knitting cotton, linen thread, carpet-linings, burlaps, carpet thread, feathers, horse blankets, and most domestic goods, have been put up in bales, composed of several lesser packages, generally of uniform size or weight, pressed and bound together in one compact bundle or bale, for convenience of handling in trade and transportation. In fact there is no known article of merchandise, that will bear compression, which has not been usually pressed into compact packages or bales, in order to reduce its bulk and to make it more convenient to handle.

This is within common knowledge, and the fact was not controverted by complainant.

The Hon. Circuit Judge, Drummond, in deciding the case below, said:

> "If the plaintiff's patent is construed so as to include any mode of pressure by which the bale is formed out of small packages of plasterer's hair, as his counsel seem to claim, then I think the patent cannot be sustained; because a person can put many articles of merchandise in separate and distinct packages, and

> then compress them together, and that is something which might occur to any person, to take almost any article of merchandise, put it in separate parcels and bind them together. It is an exercise of the ordinary skill possessed by most persons."
>
> 8 Bissell's reports, 510, King vs. Frostel (Trostel).

It was not alleged or shown that the respondents pressed their bales in the same kind of press or in the same manner as the appellant. If the patent be construed as limited to a bale made and pressed in a particular manner and with the use of a peculiar apparatus, then no infringement was established. 8 Biss., 510.

But that is not the appellant's claim. His patent is "for putting *plasterer's hair* in packages, and compressing and fastening them together in the manner described, so as to constitute a bale."

For this the appellant was not and is not entitled to a patent.

It has been repeatedly held by this Court that a mere substitution of material, or change of form, or application of an old process or method to a new subject, is not invention.

Thus in BROWN vs. PIPER, 91 U. S. 37, it was held that a patent for a new and improved method of preserving fish and meats, was void, though the patentee might have been the first to apply the method to those subjects.

This Court said that it

> "was simply the application of an old process to a new subject, without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent law. The thing was within the circle of what was well known before and belonged to the public. No one could lawfully appropriate it to himself and exclude others from using it in any unusual way for which it may be desired to apply it."

The principle of that case was held applicable and controlling in TERHUNE vs. PHILLIPS, 99 U. S., 592, in which a patent for an improvement in show cases, consisting in the mere substitution of metal for wood in corner sockets for show cases, was held invalid for want of invention.

So an improvement in straps for shawls, consisting in making the cross piece to which the handle loop is attached stiffer and firmer by the use of metal or other substance, was held not to be the subject of a patent.

CROUCH vs. ROEMER, 103 U. S., 797.

In HOTCHKISS vs. GREENWOOD, 11 How. 248, the Supreme Court held that the substitution of porcelain or clay door-knobs for metal, etc., attached to the shank in the same manner, was not patentable, neither the knobs, nor the metallic shank or spindle, being new, and the improvement consisting only in the superiority of the material (itself not new) over that previously used in making the knob.

In the opinion, Mr. Justice Nelson referred to a case tried by him at the Circuit involving a patent for a button made of wood, having its face covered with tin bent over the rim so as to be firmly secured to the wood, making a cheap and useful article for common wear, and in great demand. Defendant on the trial produced a button taken from a coat worn before the revolution, which was made in the same way, bone being used instead of wood.

An improved wagon reach,—the improvement consisting of the use of iron in place of wood or iron and wood, but retaining the same shape and performing the same office and in the same manner as before, is not patentable.

> "The use of one material instead of another in constructing a known machine is, in most cases, so obviously a matter of mere mechanical judgment and not of invention, that it connot be called an invention, unlesss some new and useful result, an increase of efficiency, or a decided saving in the operation, is clearly attained Some evidence was given to show that the wagon-reach of the plaintiff is a better reach, requiring less repair, and having greater solidity than the wooden reach. But it is not sufficient to bring the case out of the category of more or less excellence of construction. The machine is the same. Axe-helves made of hickory may be more durable and more cheap in the end than those made of beech or pine, but the first application of hickory to the purpose would not be, therefore, patentable."

HICKS vs. KELSEY, 18 Wall., 670.

Neither is the first application of the ancient paper, pressure and tow string to plasterer's hair, *therefore*, patentable.

Higher finish, greater beauty of surface, or increased commercial value, does not render an article of manufacture patentable. Such superiority is due sometimes to the skill of the workman, and sometimes to the perfection of the machinery employed. Such improvements are within the category of degree.

SMITH VS. NICHOLS, 21 Wall., 112.

In COLLAR COMPANY VS. VAN DUSEN, 23 Wall., 530, the patentee was held not to be the inventor of the collar in question, although he was the first to use the particular kind of paper described in his patent. It is said in the opinion that

> "Articles of manufacture may be new in a commercial sense, when they are not new in the sense of the patent law. New articles of commerce are not patentable as new manufactures, unless it appears in the given case that the production of the new article involved the exercise of invention or discovery beyond what was necessary to construct the apparatus for its manufacture or production. Nothing short of invention or discovery will support a patent for a manufacture, any more than for an art, machine or composition of matter."

In GLUE CO. V. UPTON, 97 U. S., 3, the court held void a patent for an alleged improvement in the manufacture of glue.

The invention consisted of ordinary flake glue reduced to small particles by mechanical division, and the patentee's claim was to the comminuted glue as "an article of manufacture." The court say,

> "The advantages from such division consist in its more ready and rapid solution, its greater convenience for packing and retailing and its whiter appearance and enhanced saleableness.
>
> The whole claim is to an old article of commerce, in a state of mechanical division greater than previously used, but unchanged in composition and properties, and the benefits arising from the increased division, are such as appertain to every soluble substance when divided into minute particles."

The court further say, respecting the distinction between a new article of commerce, and a new article which, as such, is patentable:

> "Any change in form from a previous condition, may render the article new in commerce; as powdered sugar is a different article in commerce from loaf sugar, and ground coffee is a different article in commerce from coffee in the berry. But to render the article new in the sense of the patent law, it must be more or less efficacious, or possess new properties by a combination with other ingredients; not from a mere change of form produced by a mechanical division," &c.

If mechanical division of a well known article of commerce does not make it a new article in the sense of the patent law, can the mechanical aggregation of a well known article of commerce be patentable as a new invention?

Again, in DALTON v. JENNINGS, 93 U. S., 271, a patent for an improvement in ladies' hair-nets was declared invalid for want of novelty. In the improved nets the meshes were made of larger cords or threads crossing each other at various angles, combined with finer threads, filling up the spaces and making the interstices smaller. The same method of construction had been observed in the tidy, the mosquito bar, lace, and various other fabrics which had been made and were in public use for a long time previous to the application for the patent.

Mr. Justice Miller, delivering the opinion of the court, expressed doubt that netting of the kind patented by the appellant could be deemed an invention within the meaning of the patent law, *even if produced by him for the first time.*

Other cases of patents held invalid for want of invention, are

PEARCE v. MULFORD, 102 U. S., 112.

DENSMORE v. SCOFIELD, 102 U. S., 375.

Jacking C. Cases, 105 U. S. 566.

Pickering v. McCullough, 104 U. S. 310.

The Circuit Courts have repeatedly applied the same principles.

Thus an improvement in starch trays, consisting of forming the bottoms of sheet metal, has been held not patentable for want of invention, the court saying "it is within common knowledge that such linings had been used analogously in many other vessels to contain liquids, because of the same advantages."

N. Y. GRAPE SUGAR CO. vs. AMER. GRAPE SUGAR CO., Cir. Ct. North'n. Div. N. Y., 10 Fed. Rep., 835.

An improved window cleaner, consisting of an elastic rubbing strip attached to a handle or holder, combined, &c., for cleaning mirrors, windows, &c., was held not patentable, because the erasive and cleaning qualities of rubber have been long known, and its use in cleaning

window glass is but a new use of an old and well known article. The device lacked invention, being merely the result of mechanical skill.

PERFECTION WINDOW CLEANER v. BOSLEY, Cir. Ct., East'n Dist., Wis., 2 Fed. Rep. 574.

An improvement in insulating Telephone wires, consisting in "Compressing the plastic paraffine by suitable machinery, after the fibrous covering and the paraffine had been applied," has been held not patentable.

"The invention consisted in the discovery that compression of the plastic paraffine into the pores of the fibrous covering, by any well known mechanical appliances, would be advantageous." "Wire covered with braided fibrous covering and dipped in wax, was in common use." Bitumen had also been before used in like manner for insulation. "The patented process was simply the application by the patentee of an old process to a new subject, without any exercise of the inventive faculty."

WEST'N ELEC. MANUF. CO. v. ANSONIA BRASS & COPPER CO. Cir. Ct. Dist. Conn. (Dec. 12, '81.) Shipman, D. J.

So of a patent for a new and improved mode of pitching barrels.

"There is no patentable invention in using the same mechanism for the purpose of applying a blast of hot air to the interior of beer casks, to heat them, as had previously been used to apply a blast of hot air of the same character to the interior of molds and other receptacles for the same purpose." "The patentees took old and well known mechanical contrivances for accomplishing useful results, and applied them to a new purpose. In this there was nothing to support a claim for a patentable invention or process." "The interior of molds and other receptacles had been previously heated by a hot blast, and the patentees used a blast of the same character, to heat the interior of beer casks."

GOTTFRIED v. CRESCENT BREWING CO., Cir. Ct. Dist. of Indiana, 9 Fed. Rep., 762.

A stay strip with beaded edges, for covering seams of boots and shoes, was held not patentable, because on proof of the state of the

art, it appeared that similar strips had been used in harness and in ladies' belts, and straps for pocket books and other articles.

SMITH ET AL. v. MERRIAM ET AL, 6 FED. REP. 903. Cir. Ct. Mass., Lowell, C. J.

See also SLAWSON v. R. R. CO., 4 FED. REP., 531.

PRATT v. ROSENFIED, 3 FED. REP., 333.

LANGDON v. GROAT, 1 PAINE, C. C., 203.

What evidence of invention is there in the appellant's bale? In what does the invention consist? Is it in the use of bags or sacks to contain the hair? No. In the compression of the hair? No. In the tieing of several packages together for convenience of handling? No. Bags and sacks, compression, and the union of several packages in one bale have been employed ever since commerce began, in putting up an endless variety of articles of commerce.

Does the invention consist in the compression of several packages together at once to form a bale, or in the degree of pressure, or in the means of applying it, or in the exact size or weight of the smaller packages forming the bale?

What is there new or original in either of these? What skill or invention was required to find out that several small bundles of plasterer's hair of equal weight could be bound or pressed into one bale, as well as feathers, cotton batts, yarns, thread, or other merchandise?

It was claimed by the appellant that testimony showing want of novelty was inadmissible, because the answer failed to specify when, where and by whom the patented device had been before used, as required by statute.

The answer is, that evidence of the state of the art is always admissible without notice, or averment in the answer touching the subject. "It consists of proof of what was old and in general use at the time of the alleged invention. It is received for three purposes and none other,—to show what was then old, to distinguish what was new, and to aid the Court in the construction of the patent."

BROWN VS. PIPER, 91 U. S., 37.

The Court can take judicial notice of things within the common knowledge and use of the people throughout the country, and can give it the same effect as if it had been set up as a defence in the answer and the proof were plenary.

BROWN vs. PIPER, supra.

TERHUNE vs. PHILLIPS, 99 U. S., 592.

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In Terhune vs. Phillips, this Court said

> "We cannot fail to take judicial notice that the thing patented was known and in general use long before the issuing of the patent. The substitution of metal for wood was destitute both of patentable invention and utility. The admission of improper testimony, if it occurred, was, therefore, immaterial. The case of the appellant as it appears in the record, without any testimony, is clear and conclusive against him."

So, in the case now before the Court, the Court must take judicial notice of the fact that articles of commerce had from the earliest times been commonly put up in compressed bales, like the appellant's bale of hair, for the convenience of trade and of transportation. If this patent is valid it covers every such bale, whether of plasterer's hair or of other merchandise.

The patent cannot be sustained merely as applied to hair. If the bale be patentable at all, it must be because it is a new and original invention; and not because the patentee was the first to apply it to hair. If it was before well known and in general use as a mode of packing and putting up various articles of trade, then it is clear that its application to plasterer's hair is not invention, and is not ground for an exclusive right under the patent laws.

Is it not just to say of this patent, that it is simply a bold attempt, under cover of the patent laws, to secure a partial monopoly of the trade in plasterer's hair, by appropriating to himself alone the use of common and convenient modes of packing the article for sale and transportation, and by excluding all other packers and vendors of the article from such use?

The patent laws are not designed to hamper the commerce of the country, but to encourage invention and discovery, by protecting the

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